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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,302	10/15/2003	David H. Masury	0194-2001US02	7115
7590	11/15/2005		EXAMINER	
Kevin M. Farrell Pierce Atwood Suite 350 One New Hampshire Avenue Portsmouth, NH 03801			NGUYEN, VI X	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 11/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/686,302

Applicant(s)

MASURY ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-21, 24-26, 30-31 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5-6 and 9-10 of U.S. Patent No. 6,645,216. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: a surgical scalpel comprising: a housing has a window, a blade carrier includes a single use indicator, where the single use indicator is a flexible convex element that is irreversibly collapsed when the

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blade carrier is moved to the extended position. As to claims 24-26 and 35 are not patentably distinct from each other because they are essentially the same as those in the cited patent.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-23,27-28,30-33 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohn et al. (6,053,929).

Cohn et al disclose in figures. 25,28-29, a surgical scalpel having the limitations as recited in the above listed claims, including: a housing (412) has an internal channel and a viewing window (436), a blade carrier (420) slidably disposes in the channel, where the blade carrier includes a single use indicator (432 is considered as a single use indicator) that is visible through the viewing window when the blade carrier is in the retracted position and is capable of altering when the blade carrier is moved to the extended position. Note that the procedure in figure 30 discloses the single use indicator can be a flexible convex element when the blade carrier is in the extended position, where the portion of the blade carrier is tapered to form a shimming plane at best seen in fig. 29, and where the device further has one or more tapered ribs (along the side of element 450), and where the device further has a palm support removably (430) which attached to the housing (fig. 27).

Claims 20-22,24-26,29-30,34-35 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Gringer (6,058,607).

Gringer discloses in figures.4, 7-8, a device having the limitations as recited in the above listed claims, including: a housing (2) has an internal channel and a viewing window (14), a blade carrier (22) slidably disposes in the channel, where the blade carrier includes a single use indicator (10 is considered as a single use indicator) that is visible through the viewing window when the blade carrier is in the retracted position and is capable of altering when the blade carrier is moved to the extended position. Note that the procedure in figure 37 discloses the single use indicator can be a flexible convex element when the blade carrier is in the extended position, where the portion of the blade carrier is tapered to form a shimming plane at best seen in fig. 8, where the housing includes a slot (8), where the blade carrier includes an actuator/locking (36) that extends through the slot, where the slot includes a ramp (20) formed therein for engaging the actuator/locking when the blade carrier is in the extended position, and where the blade carrier includes a leaf spring (60) that extends outwardly therefrom, where the housing is a molded plastic housing (see col. 8, lines 60-66).

### *Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,752,968 to Jolly

U.S. Pat. No. 4,491,132 to Aikins

U.S. Pat. No. 6,626,925 to Newman

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn VP  
11/9/2005

*Julian W. Woo*

**JULIAN W. WOO  
PRIMARY EXAMINER**